

asserts that “claims 35-39, 42, and 44-118 are directed to an invention that is independent or distinct from the invention originally claimed . . . [because] the originally presented claims were not drawn to the combination of the hinge, plates and cosmetic.” Id. Such a conclusory assertion contravenes M.P.E.P. § 816, which expressly requires a concise statement of the “particular reasons” for holding that subject matter is independent or distinct, and also specifies that “[a] mere statement of conclusion is inadequate.”

Moreover, the Office Action does not address the fact that originally-filed claim 8 was directed to a cosmetic case, and there is nothing explaining why claims 1-15, 17-39, 42, and 44-118 were withdrawn even though claim 8 was previously examined. Further, notwithstanding the Office Action’s conclusory assertion concerning newly submitted claims 35-39, 42, and 44-118 being “independent or distinct” from original claims, the Office Action does not explain why claims 1-15 and 17-34 were withdrawn along with claims 35-39, 42, and 44-118.

Even if it might be possible to formulate some reason for asserting that the claims might be independent or distinct, pending claims 1-15 and 17-118 should all be examined together because it would not constitute an undue burden to search the subject matter of claims 1-15 and 17-118 together. “If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” M.P.E.P. § 803 (emphasis added). Applicant submits that the search required to properly examine claims 40, 41, and 43 would necessarily involve an over-lapping search for the subject matter of claims 1-15, 17-39, 42, and 44-118. Such an over-

lapping search provides a clear reason why there would be no undue burden. Further, since the cosmetic subject matter of original claim 8 was previously examined, there would be no serious burden to examine the subject matter now recited in claims 1-15, 17-39, 42, and 44-118. Consequently, the withdrawal of claims 1-15, 17-39, 42, and 44-118 is improper.

For at least these reasons, Applicant respectfully requests that the Examiner rejoin claims 1-15, 17-39, 42, and 44-118 and examine those claims on the merits.

Turning to claims 40, 41, and 43, which were examined without being withdrawn, claim 41 was indicated as being allowable upon rewriting that claim in independent form; claim 40 was rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,707,017 to Paquette ("Paquette"); and claim 43 was rejected under 35 U.S.C. § 103(a) as being obvious over Paquette.

Applicant greatly appreciates the Examiner's indication that claim 41 includes allowable subject matter.

Regarding the Section 102(b) rejection of claim 40 and the Section 103(a) rejection of claim 43, Applicant respectfully submits that those rejections should be withdrawn because Paquette does not disclose or suggest a magnetic hinge including, among other elements, at least one first magnet "in" a first plate, as recited in claims 40 and 43.

Paquette discloses magnets 1 and 3 attached to a door 4 and a wall 5 via a "plate 2" and a combination of a supporting member 6 and "attachment plate 7," respectively, without having either of the magnets "in" any structure of Paquette's disclosed arrangement. For example, both of the magnets 1 and 3 are completely

exposed without any portion of either of the magnets 1 and 3 being "in" either the door 4, wall 5, "plate 2," supporting member 6, or "attachment plate 7." Thus, Paquette lacks any disclosure or suggestion of at least one first magnet "in" a first plate, as recited in claims 40 and 43.

For at least the reasons set forth above, the Section 102(b) and 103(a) rejections should be withdrawn and claims 40 and 43 should be allowed.

Applicant respectfully requests that the Examiner reconsider the application, examine and allow all of the pending claims, and issue a Notice of Allowability in a timely manner.

Applicant notes that the Office Action contains a number of assertions concerning the claims and cited references. Applicant declines to subscribe to any assertion in the Office Action regardless of whether it might be addressed specifically herein.

If a telephone conversation might advance prosecution of the present application, the Examiner is invited to contact the undersigned (571-203-2774).

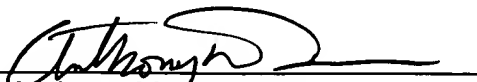
Please grant any extension of time and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: December 29, 2004

By: _____


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